



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/583,345

06/19/2006

Peter Kwok Hing Lam

P71317US0

9774

136 7590 05/12/2009

JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER

ENG, ELIZABETH

ART UNIT

PAPER NUMBER

4151

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,345	Applicant(s) LAM ET AL.	
	Examiner ELIZABETH ENG	Art Unit 4151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 8,9,11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/29/2007</u> . | 6) <input type="checkbox"/> Other: ____. |

Detailed Action

35 USC 112 Rejection

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation of a di, tri, or multiblock, and the claim also recites preferably a tri or multiblock, or most preferred a tri block or a star block which is the narrower statement of the range/limitation.

Claim Objections

1. Claims 8, 9, and 11 are objected to because of the following informalities:
Regarding claims 8 and 9, --20 000 and 100 000-- should read either --20,000 and 100,000-- or --20000 and 100000--. Regarding claim 11, --swell able-- should read --swellable--. Appropriate correction is required.

35 USC 102 Rejection

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 102 (b) as being anticipated by Gothjaelpson et al. (PGPUB 2002/0120032).
3. Regarding claim 1, Gothjaelpsen et al. teaches an adhesive composition [abstract, line 2] comprising rubbery elastomeric ["putty-like", abstract, line 2] matrix comprising a block-copolymer and a homopolymer where the block-copolymer contains two blocks of a polymerised mono alkenyl arene monomer and consisting of a saturated hydrocarbon chain [styrene-ethylenebutylene-styrene (SEBS), 0026, line 6] characterized in that the homopolymer is a hydrocarbon chain made from the same monomer as said block(s) consisting of a saturated hydrocarbon chain [polybutylene, 0027, line 4].

Art Unit: 4151

4. Regarding claim 2, Gothjaelspen et al. teaches an adhesive composition according to claim 1, wherein the block(s) in the block-copolymer consisting of a saturated hydrocarbon chain [styrene-ethylenebutylene- styrene (SEBS), 0026, line 6] and the homopolymer have the same chemical structure [polybutylene, 0027, line 4].

5. Regarding claim 3, Gothjaelspen et al. teaches the adhesive composition according to claim 1, wherein the block copolymer is a triblock copolymer [styrene-ethylenebutylene-styrene, 0026, line 8].

6. Regarding claim 4, Gothjaelspen et al. teaches the adhesive composition according to claim 1 wherein the block(s) of a polymerised mono alkenyl arene monomer form a physically cross-linked matrix [0026, line 3].

7. Regarding claim 5, Gothjaelspen et al. teaches the adhesive composition according to claim 1 wherein the polymerized mono alkenyl arene is polystyrene [styrene-ethylenebutylene-styrene, 0026, line 8].

8. Regarding claim 6, Gothjaelspen et al. teaches the adhesive composition according to claim 1, wherein the saturated hydrocarbon chain is polyisobutylene [polybutylene, 0027, line 4].

9. Regarding claim 9, Gothjaelspen et al. teaches the composition according to claim 1, wherein the homopolymer has a molecular weight between 10,000 to 120,000 [0027, line 10], wherein the range encompasses the claimed range of 20,000 and 100,000.

10. Regarding claim 10, Gothjaelspen et al. teaches the adhesive composition according to claim 1, comprising from 1 to 20 % by weight of block-copolymer [0016]

Art Unit: 4151

and up to 5 to 60% by weight of the tackifying polybutylene liquid [0017], wherein the ranges are within the claimed range of 1 to 70% by weight of block copolymer, and up to 70% by weight of homopolymer.

11. Regarding claim 11, Gothjaelspen et al. teaches the composition according to claim 1, characterized in that the composition comprises one or more water-soluble or water swellable hydrocolloids [0031, lines 5-7].

12. Regarding claim 12, Gothjaelspen et al. teaches the adhesive composition according to claim 11, wherein the composition comprises from 20-70% by weight of one [0031] or more [CMC, pectin, gelatine, 0034, line 4] water soluble or water swellable hydrocolloids [0031, line 13], wherein the range overlaps the claimed range of 5-60 % by weight.

13. Regarding claim 13, Gothjaelspen et al. teaches the adhesive composition according to claim 1 wherein the adhesive composition comprises a tackifier resin [0034, line 3].

14. Regarding claim 14, Gothjaelspen et al. teaches an ostomy appliance [0001, line 5] with an adhesive wafer [0002, line 9] comprising an adhesive composition according to claim 1.

15. Regarding claim 15, Gothjaelspen et al. teaches the adhesive is used for wound care purposes [0033, line 4], wherein this reads on the claim of a wound dressing comprising an adhesive composition according to claim 1.

Art Unit: 4151

16. Claims 1-5, 7-10, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Korpman et al. (US Pat. No. 5,760,135).

17. Regarding claim 1, Korpman et al. teaches an adhesive composition [Abstract, line 1] comprising rubbery elastomeric matrix [column 1, line 30] comprising a block-copolymer and a homopolymer. The block copolymer comprises at least two polymer blocks A and at least one polymer block B, wherein block A is a thermoplastic styrene block [claim 9, line 26] and block B isoprene [claim 9, line 28]. The homopolymer is a liquid rubber consisting of isoprene [claim 9, line 14].

18. Regarding claim 2, Korpman et al. teaches an adhesive composition according to claim 1, wherein the block(s) in the block-copolymer consisting of a saturated hydrocarbon chain [isoprene, claim 9, line 28] and the homopolymer have the same chemical structure [liquid isoprene, claim 9, line 14].

19. Regarding claim 3, Korpman et al. teaches the adhesive composition according to claim 1, wherein the block copolymer is a triblock copolymer, wherein the triblock is an ABA block [column 3, line 31] wherein A is styrene and B is isoprene [claim 9, lines 22-29].

20. Regarding claim 4, Korpman et al. teaches the adhesive composition according to claim 1 wherein the block(s) of a polymerised mono alkenyl arene monomer form a physically cross-linked matrix [column 4, line 31].

21. Regarding claim 5, Korpman et al. teaches the adhesive composition according to claim 1 wherein the polymerized mono alkenyl arene is polystyrene [block A, claim 9, line 25].

Art Unit: 4151

22. Regarding claim 7, Korpman et al. teaches the composition according to claim 1 wherein the block(s) of a polymerised mono alkenyl arene monomer A has a molecular weight of 6000 to 30,000 [column 3, lines 39-40], wherein the range overlaps the claimed range of between 1000 and 10000.

23. Regarding claim 8, Korpman et al. teaches the composition according to claim 1, wherein the block(s) consisting of a saturated hydrocarbon chain has a molecular weight 75000 to 225000 [column 3, line 46] wherein the range reads on the claimed range of between 20 000 and 100 000.

24. Regarding claim 9, Korpman et al. teaches the composition according to claim 1, wherein the homopolymer has a molecular weight of 10,000 to 75,000 [column 4, line 21], wherein the range overlaps the claimed range of 20,000 and 100,000.

25. Regarding claim 10, Korpman et al. teaches the ratio of rubber block copolymer to liquid homopolymer is 1:1 to about 1:4.0 [claim 2], which is 20-50% by weight rubber block copolymer and 80-50% by weight liquid homopolymer, wherein the ranges are within the claimed range of 1 to 70% by weight of block copolymer, and overlaps the claimed range of up to 70% by weight of homopolymer.

26. Regarding claim 13, Korpman et al. teaches the adhesive composition according to claim 1 wherein the adhesive composition comprises a tackifier resin [column 3, line 20].

27. Regarding claim 14, Korpman et al. teaches a pressure sensitive adhesive can be used as free films or coated on a substrate [column 6, line2 51-52] and a pressure sensitive adhesive that can be used in health care products for skin adhesion [column 9,

Art Unit: 4151

line 30], particularly an adhesive that can be a vehicle to attach a (drug) reservoir to the skin [column 9, line 39], which reads on the claim of an ostomy appliance with an adhesive wafer comprising an adhesive composition according to claim 1.

28. Regarding claim 15, Korpman et al. teaches a pressure sensitive adhesive coated a on a substrate slit into desired widths to form pressure sensitive adhesive tapes or bandages, wherein this reads on the claim of a wound dressing comprising an adhesive composition according to claim 1.

35 USC 103 Rejection

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

31. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 4151

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

32. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gothjaelspen et al. as applied to claim 1 above, and further in view of Korpman et al. (US Pat. No. 5,760,135).

33. Regarding claim 7, Gothjaelspen et al. does not teach the block(s) of a polymerised mono alkenyl arene monomer a has a molecular weight of 1,000 to 10,000. However, in the same field of endeavor of forming adhesives, Korpman et al. teaches the composition according to claim 1 wherein the block(s) of a polymerised mono alkenyl arene monomer a has a molecular weight of 6,000 to 30,000 [column 3, lines 39-40], wherein the range overlaps the claimed range of between 1000 and 10000, for the benefit of yielding an adhesive with sufficient adhesive and tacky properties.

34. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the block copolymer of Gothjaelspen et al. to have the styrene molecular weight of Korpman et al., for the benefit of yielding an adhesive with sufficient adhesive and tacky properties.

35. Regarding claim 8, Gothjaelspen et al. does not teach wherein the block(s) consisting of a saturated hydrocarbon chain has a molecular weight of between 20,000 and 100,000. However, Korpman et al. teaches a saturated hydrocarbon chain with a

Art Unit: 4151

molecular weight of 75,000 to 225,000 [column 3, line 46] wherein the range reads on the claimed range of between 20,000 and 100,000, for the benefit of yielding an adhesive with sufficient adhesive and tacky properties.

36. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the block copolymer of Gothjaelspen et al. to have the hydrocarbon chain molecular weight of Korpman et al., for the benefit of yielding an adhesive with sufficient adhesive and tacky properties.

37. Claims 6, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korpman et al., as applied to claim 1 above, and further in view of Gothjaelspen et al.

38. Regarding claim 6, Korpman et al. does not teach wherein the saturated hydrocarbon chain is polyisobutylene. However, in the same field of endeavor of forming an adhesive, Gothjaelspen et al. teaches the saturated hydrocarbon chain is polybutylene [0027, line 4], for the benefit of yielding an adhesive with a sufficient amount of stickiness.

39. Regarding claim 11, Korpman et al. does not teach the composition comprising one or more water-soluble or swellable hydrocolloids. However, Gothjaelspen et al. teaches the composition according to claim 1, characterized in that the composition comprises one or more water-soluble or water swellable hydrocolloids [0031, lines 5-7], for the benefit of yielding an adhesive that would absorb moisture from the body in order to increase the wearing-time of the adhesive.

Art Unit: 4151

40. Regarding claim 12, Korpman et al. does not teach the composition comprises from 20-70% by weight of one or more water soluble or water swell able hydrocolloids. However, Gothjaelspen et al. teaches an adhesive composition that comprises from 20-70% by weight of one [0031] or more [CMC, pectin, gelatine, 0034, line 4] water soluble or water swell able hydrocolloids [0031, line 13], wherein the range overlaps the claimed range of 5-60 % by weight, for the benefit of yielding an adhesive that would absorb moisture from the body in order to increase the wearing-time of the adhesive.

41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the adhesive composition of Korpman et al. with hydrocolloids as taught by Gothjaelspen et al. for the benefit of yielding an adhesive that would absorb moisture from the body in order to increase the wearing-time of the adhesive.

Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Eng whose telephone number is (571) 270-7743. The examiner can normally be reached on Mon-Thurs from 9:00 am 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Angela Ortiz can be reached at (571) 272-1206. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-8743. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

Art Unit: 4151

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.E.

/Angela Ortiz/

Supervisory Patent Examiner, Art Unit 4151